

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence (along with any paper referred to as being attached or enclosed) is being submitted *via* the USPTO EFS Filing System on the date shown below to Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: January 30, 2007

/Jessica Sexton/

Jessica Sexton

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Appellant(s): Gerald L. Swift

Examiner: Melvin A. Cartagena

Serial No: 10/815,047

Art Unit: 3754

Filing Date: March 31, 2004

Title: ROTARY AND/OR LINEAR ACTUATOR SYSTEM FOR CONTROLLING
OPERATION OF AN ASSOCIATED TOOL

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Dear Sir:

Appellant's representative submits this Reply Brief in response to the Examiner's Answer dated November 30, 2006. In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [ALBRP241USA].

REMARKS

Claims 1-31 are currently pending and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein. In particular, the following comments address deficiencies contended in the Examiner's Answer to appellant's Appeal Brief.

I. Regarding the Rejection of Claims 1-7 and 10-19 Under 35 U.S.C. §102(b)

The Examiner incorrectly maintains the rejection of claims 1-7 and 10-19 under 35 U.S.C. §102(b) as being anticipated by Weingartner (U.S. 4,462,467). Appellant's representative respectfully requests that this rejection be reversed for at least the following reasons. Weingartner fails to disclose each and every limitation set forth in the subject claims.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes *each and every limitation* set forth in the patent claim. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). *The identical invention must be shown in as complete detail as is contained in the ... claim.* *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (emphasis added).

The claimed invention relates to a linear/rotary actuator that operates on a moveable member to aid in controlling the operation of an associated tool. In particular, independent claims 1 recites a system that facilitates operation of a tool, comprising a moveable member having a length, that moves in a rotary motion about a central axis and a linear motion along the central axis *to position an associated drive member*; and *the drive member is parallel to the central axis*, and extends the length of the moveable member to engage the tool, *which drive member operates independently of the moveable member*. Independent claim 12 recites similar aspects. Weingartner is silent regarding such novel aspects of the subject claims.

Weingartner relates to a percussion drill machine that imparts percussive force to a drilling tool. The cited reference employs a free piston that imparts the force to drive an associated rod member to facilitate the operation of an associated tool. At page 5 of the Examiner's Answer, the Examiner contends that the motor taught by Weingartner, which

positions a drive member by utilizing the free piston's reciprocating force, equates to the features recited in independent claims 1 and 12. Appellant's representative respectfully disagrees. The cited reference utilizes the free piston to drive the drive member to perform a desired function, while the claimed invention, on the other hand, utilizes the moveable member to position an associated drive member and subsequently operates the associated drive member independent of the moveable member. In other words, Weingartner utilizes the free piston to operate the drive member, while the claimed invention operates the drive member independent of the moveable member. Moreover, this distinction between Weingartner and the claimed invention is further exemplified in claim 1. Weingartner provides a free piston and a rod drive member that travel along the same axis, while the claimed invention teaches a moveable member...*that moves in a rotary motion about a central axis and a linear motion along the central axis...and a drive member that is parallel to the central axis.*

In view of at least the foregoing, it is readily apparent that Weingartner does not teach the identical invention in as much detail as is contained in the subject claims. Accordingly, this rejection with respect to independent claims 1 and 12 (and the claims that depend there from) should be reversed.

II. Regarding the Rejection of Claims 8, 9 and 20-22 Under 35 U.S.C. §103(a)

The Examiner incorrectly maintains the rejection of claims 8, 9 and 20-22 under U.S.C. §103(a) as being unpatentable over Weingartner in view of Riello *et al.* (U.S. 6,216,798). Withdrawal of this rejection is requested for at least the following reasons. The cited references, alone or in combination, do not teach or suggest every limitation of the subject claims.

As discussed *supra* with respect to claims 1 and 12, Weingartner fails to disclose a moveable member having a length, that moves in a rotary motion about a central axis and a linear motion along the central axis to position an associated drive member; and the drive member is parallel to the central axis, and extends the length of the moveable member to engage the tool, *which drive member operates independently of the moveable member*. Riello *et al.* fails to compensate for the deficiencies of Weingartner. Rather, Riello *et al.* concerns work units for automatic machine tools in which a spindle moves in translation and rotates with respect to a work axis for operation of an associated tool. In the Examiner's Answer, the Examiner incorrectly equates the sleeve taught by Riello to the moveable member of the claimed invention.

The sleeve taught by Riello houses the spindle (e.g. drive member) such that the sleeve can move axially along an axis while the inner spindle is axially fixed but is able to rotate about the axis. The sleeve taught in the cited reference is limited to moving axially along the axis, while the moveable member of the claimed invention can both rotate about an axis and move linearly along the axis in order to position an associated tool. Therefore, the sleeve of Riello does not equate to the moveable member of the claimed invention.

Moreover, as noted above with regard to claim 1, the claimed invention teaches a moveable member...*that moves in a rotary motion about a central axis and a linear motion along the central axis...and a drive member that is parallel to the central axis*. Since the spindle taught by Riello is housed within the sleeve and moves about the same axis as the sleeve, the spindle is not parallel to the axis on which the moveable member operates.

In view of at least the foregoing, it is readily apparent that Weingartner and Riello *et al.* do not teach or suggest all limitations of the subject claims. Accordingly, this rejection should be reversed.

III. Conclusion

The subject application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [ALBRP241USA].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact appellant's undersigned representative at the telephone number below.

Respectfully submitted,
AMIN, TUROCY & CALVIN, LLP

/Himanshu S. Amin/
Himanshu S. Amin
Reg. No. 40,894

AMIN, TUROCY & CALVIN, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731